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In re Application of :
BRUGOT, Alain, et al. :
U.S. Application No.: 09/331,674 :
PCT No.: PCT/FR97/02360 :
International Filing Date: 19 December 1997 :
Priority Date: 23 December 1996 :
Attorney's Docket No.: Q54768 :
For: METHOD FOR PRODUCING IMAGES :
HAVING AT LEAST A CODED PART :
INDISCERNIBLE TO THE NAKED EYE :

DECISION ON
PETITION UNDER
37 CFR 1.181

This decision is issued in response to applicants' "Submission Of Executed Declaration And Verified English Language Translation" filed on 23 August 1999, which is being treated as a petition under 37 CFR 1.181 to confirm compliance with the Notification of Missing Requirements (Form PCT/DO/EO/905) mailed on 21 July 1999. No petition fee is required.

BACKGROUND

On 19 December 1997, applicants filed international application PCT/FR97/02360 which claimed a priority date of 23 December 1996 and which designated the United States. On 02 July 1998, a copy of the international application was transmitted to the United States Patent and Trademark Office ("Office") by the International Bureau.

On 21 July 1998, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee was extended to expire 30 months from the priority date, i.e., 23 June 1999.

On 23 June 1999, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, a check in the amount of \$1,100 (\$840 as the basic national fee and \$260 as for inclusion of a multiple dependent claim).

Application No. 09/331,674

On 21 July 1999, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905). The Notification indicated that applicants were required to submit the following materials: (1) a translation of the application into English; (2) a processing fee for filing the translation after the 30 month deadline; (3) an oath or declaration in compliance with 37 CFR 1.497; and (4) a surcharge for providing the oath or declaration after the 30 month deadline. The Notification also informed applicants that the failure to submit these materials within one month of the date of the Notification would result in abandonment of the application.

On 23 August 1999, applicants filed the "Submission Of Executed Declaration And Verified English Language Translation" considered herein, accompanied by a purported English translation of the international application and an executed declaration. 21 August 1999 was a Saturday; thus, this Submission is considered to have been filed within one month of the 21 July 1999 mail date of the Notification of Missing Requirements.

DISCUSSION

The Submission included an express authorization for the Office to "charge the statutory fee of \$130 to Deposit Account No. 19-4880." This authorization, in conjunction with the broad authorization to charge contained in the original transmittal letter, is being interpreted to authorize a charge to Deposit Account No. 19-4880 for both of the \$130 fees referred to in the Notification of Missing Requirements, that is, the fee for filing the English translation after the 30 month deadline and the fee for filing the declaration of inventors after the 30 month deadline. Thus, applicants have complied with that portion of the Notification of Missing Requirements which refers to these two fees.

However, the declaration of inventors and the purported English translation submitted by applicants both are insufficient. Regarding the declaration, the handwritten residence information for inventor Alain Brugot is illegible, as are the printed names for the inventors.

Regarding the translation, 35 U.S.C. 371(c)(2) requires applicants to submit "a translation into the English language of the international application." Here, the published international application contains 11 numbered claims. However, the purported English translation contains only 10 numbered claims. In order to satisfy 35 U.S.C. 371(c)(2), applicants must submit an English translation of the entire international application, including claim 11. It is noted that the International Preliminary Examination Report ("IPER") has annexes attached to it which contain amendments to the international application, including an amended version of the claims in which claim 11 has been eliminated. These amendments do not eliminate the need for applicants to supply an English translation of the complete international application. Rather, applicants are required to provide the English translation of the published international application and, under 35 U.S.C. 371(c)(5), an English translation

of the annexes to the IPER which contain the amendments that, among other changes, eliminated claim 11.

CONCLUSION

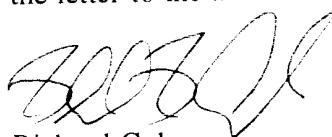
Applicants' petition to confirm compliance with the Notification of Missing Requirements is **DISMISSED** without prejudice.

Applicants have **one (1) month** from the mailing date of this Decision to submit a proper response. Failure to provide a proper and timely response will result in abandonment. A proper response must include an acceptable English translation of the complete, pre-amendment version of the international application, as discussed above, as well as a completely legible declaration of the inventors.

Extensions of time may **not** be obtained under 37 CFR 1.136(a).

Deposit Account No. 19-4880 has been charged \$130 as the fee for filing the declaration of inventors after the 30 month deadline, and \$130 as the fee for filing the English translation of the international application after the 30 month deadline.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.



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